

REMARKS

The present application was filed on August 18, 2000 with claims 1-23. The independent claims are 1, 11 and 20.

In the outstanding Office Action dated April 7, 2004, the Examiner: (i) rejected claims 3 and 13 under 35 U.S.C. §101 as being inoperative; (ii) rejected claims 1, 4-9, 11 and 14-23 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,577,120 to Penzias (hereinafter "Penzias"); and (iii) rejected claims 2, 10 and 12 under 35 U.S.C. §103(a) as being unpatentable over Penzias in view of U.S. Patent No. 4,993,068 to Piosenka et al. (hereinafter "Piosenka").

In this response, Applicants amend claims 3 and 13 in an effort to further clarify the inventions recited therein. Applicants also amend independent claims 1, 11 and 20 to correct non-substantive minor informalities. Applicants traverse the §102(b) and §103(a) rejections and request reconsideration of the present application in view of the following remarks.

With respect to the §101 rejection of dependent claims 3 and 13, Applicants respectfully submit that the amendments made thereto place the claims in condition for allowance.

With respect to the §102(b) rejections, Applicants initially note that the Manual of Patent Examining Procedure (MPEP), Eighth Edition, August 2001, §2131, specifies that a given claim is anticipated "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, MPEP §2131 indicates that the cited reference must show the "identical invention . . . in as complete detail as is contained in the . . . claim," citing Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claims 1, 11 and 20 describe methods and apparatuses "for use in a distributed collaborative computing system with two or more collaborative computing devices coupled via a communication network and respectively executing a collaborative application thereon." The Examiner, in formulating the §102(b) rejection to these claims, argues that each and every one of the limitations of claims 1, 11 and 20 is met by Penzias. More specifically, the Examiner states that:

Penzias discloses a method for retail transaction identification wherein a purchaser is required to provide identification along with biometric information, at a point of sale terminal, in the form of either height, weight, eye/hair color, fingerprint, iris image, or voice print in order to purchase a certain product. At the time of purchase, the purchaser's identification information, biometric information, and information about the transaction itself (data unit) is stored, which meets the limitation of associating one or more identifiers with data units respectively entered by one or more users at at least one of the two or more collaborative computing devices so that data entered by one or more is uniquely identifiable in the distributed collaborative computing system. The stored information is recoverable upon authorization by a central maintenance agency (Col. 2, line 37 - Col. 3, line 52), which meets the limitation of storing the data units and the one or more associated unique identifiers, the stored data units and associate (*sic*) unique identifier being accessible to the two or more collaborative computing devices in the distributed collaborative computing system in accordance with the collaborative application. (Office Action, p. 2-3).

Applicants respectfully disagree. One difference between the claims and the reference is that the claims relate to a "distributed collaborative computing system" such as, for example, "a collaborative whiteboard system," (Specification, p. 3, lines 2-4) while the reference relates to a system for "retail transaction identification." One of ordinary skill in the art will recognize that these systems perform different functions and are, therefore, not identical. To collaborate means, by way of example, to work together with others, especially in an intellectual endeavor (*Merriam-Webster Dictionary*, 1996). Correspondingly, a "distributed collaborative computing system" functions to allow users at different locations to work together for some joint purpose.

For instance, in a collaborative whiteboard system, a user at a first location is able to view information written by a user at a second location. This way, the remote users may interact as if they are in the same location (Specification, p. 2, lines 7-10). The computing system of Penzias, on the other hand, functions only to identify a user and clearly lacks any purpose in facilitating collaboration between users. In fact, according to the reference, the users of the reference's "retail transaction identification" system consist of individuals who have "engaged in a commercial, retail or other transaction" (Penzias, col 1, lines 9-12) and government agencies trying to later find the individuals, primarily as part of criminal investigations (Penzias, col. 1, lines 11-12, col. 3, line 63 - col. 4, line 10).

Applicants respectfully submit that it would be unreasonable to assert that the individuals (potentially criminals and terrorists) using the “retail transaction identification” system of Penzias are in some way working together with government agencies who are trying to search them out. As a result, the system of Penzias does not teach a “distributed collaborative computing system.” Based at least on this deficiency, Applicants respectfully submit that Penzias fails to describe every element of claim 1, 11 and 20 and, therefore, does not anticipate independent claims 1, 11 and 20.

Dependent claims 4-9, 14-19 and 21-23 are believed allowable for at least the reasons identified above with regard to independent claims 1, 11 and 20, and these claims are also believed to specify additional separately patentable subject matter.

With respect to the §103(a) rejection of dependent claims 2, 10 and 12 with reference to Penzias in view of Piosenka, Applicants respectfully submit that the Piosenka reference fails to supplement the above-described deficiencies of Penzias as applied to independent claims 1 and 11.

It is further noted, in formulating the §103(a) rejection to claims 2, 10 and 12, the Examiner states:

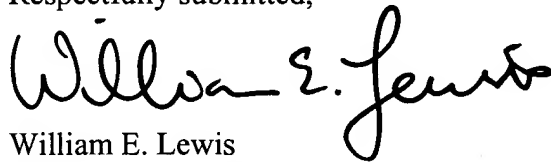
Penzias does not disclose that the point of sale terminals accepts signature biometric information. Piosenka discloses a personal identification system wherein the biometric terminal accepts signatures via a pressure sensitive tablet (Col. 5, lines 20-27, Fig. 1) (whiteboard system). It would have been obvious to one of ordinary skill in the art at the time the invention was made to authenticate the purchasers of Penzias using dynamic signature via pressure sensitive tablets in order to provide universally accepted personal identification information as taught by Piosenka (Col. 2, lines 43-48). (Office Action, p. 4-5).

The Federal Circuit has stated that when patentability turns on the questions of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent has been reinforced in myriad decisions, and cannot be dispensed with.” In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual questions of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” Id. at 1343-1344. Applicants respectfully submit that this §103(a) rejection

contains no such showing of objective evidence of record that would motivate one skilled in the art to combine the proposed references as suggested by the Examiner. Instead the above quoted language is precisely the type of subjective, conclusory statements that the Federal Circuit has indicated provides insufficient support for an obviousness rejection.

In view of the above, Applicants believe that claims 1-23 are in condition for allowance, and respectfully request the withdrawal of the §101, §102(b) and §103(a) rejections.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William E. Lewis". The signature is fluid and cursive, with the first name "William" being the most prominent part.

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